

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed November 20, 2007 (Paper No. 20071112). Upon entry of this response, claims 1-32 are pending in the application. In this response, claims 1, 11, 18, 21, and 25 have been amended. Applicant respectfully requests that the amendments being filed herewith be entered and request reconsideration and allowance of all pending claims.

I. Claim Rejections under 35 U.S.C. §112, Second Paragraph

Claims 11-17 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Office Action alleges that:

With respect to Claim 11: the phrase "sending the combination of the completed first correspondence medium an envelope" is indefinite. The phrase is grammatically incorrect, and appears to be missing an "and" between the medium and "an envelope", which causes it to be unclear.

(Office Action, page 2).

In response to the rejection, Applicant has amended claim 11. In view of these amendments, Applicant submits that claims 11-17 define the invention in the manner required by 35 U.S.C. § 112. Accordingly Applicant respectfully requests that the rejection be withdrawn.

II. Claim Rejections under 35 U.S.C. §102(e)

Claims 11-20 and 25-32 have been rejected under 35 U.S.C. § 102(b) as allegedly anticipated by *Tackbary et al.* (U.S. Patent No. 6,092,054, hereafter "*Tackbary*"). Applicant respectfully traverses this rejection as applied to pending claims 11-20 and 25-32.

As quoted in MPEP § 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Therefore, every claimed feature of the claimed invention must be

represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e). In the present case, not every feature of the amended claims is represented in the *Tackbary* reference.

A. Independent Claim 11

As provided in amended independent claim 11, Applicant claims:

A method for assisting an author in conveying a personal message, comprising:

***providing to the author a message kit comprising
a first correspondence medium configured to receive the personal message,***

a second correspondence medium configured to receive information associated with an intended recipient of the personal message, and

a first directive configured to provide notification to a fiduciary that a combination of the first correspondence medium completed with the personal message and an envelope configured to contain the first correspondence medium will be sent to the intended recipient in accordance with a preferred receipt date after the occurrence of a triggering event;

receiving the completed first correspondence medium and the second correspondence medium completed with the intended recipient information;

storing the completed first and second correspondence media; receiving notification from the fiduciary of the occurrence of the triggering event; and

sending the combination of the completed first correspondence medium and the envelope to the intended recipient.

(Emphasis added). Applicant respectfully submits that amended independent claim 11 is allowable for at least the reason that *Tackbary* does not disclose, teach, or suggest at least "providing to the author a message kit comprising a first correspondence medium configured to receive the personal message, ... and a first directive configured to provide notification to a fiduciary that a combination of the first correspondence medium completed with the personal message and an envelope configured to contain the first correspondence medium will be sent to the intended recipient in accordance with a preferred receipt date after the occurrence of a triggering event; receiving the completed first correspondence medium ...; storing the

completed first ... correspondence media; [and] receiving notification from the fiduciary of the occurrence of the triggering event" as emphasized above.

More specifically, *Tackbary* teaches:

The present invention uses a computer system for permitting buyers to communicate with a card distribution center for selecting, ordering, and sending social expression cards and for maintaining records of intended recipients, occasion dates and orders made. The user selects a recipient from a recipient database wherein at least a name and an address of the recipient is stored in the database. The user selects a card from a card database based upon the selected recipient name and based upon a card-giving occasion stored in a master occasion database. The selected recipient name and card-giving occasion appear on a video display device as textual and graphical images.

Each independent customer or buyer communicates from a remote site to the distribution center. ...

The user then orders the selected card from the card distribution center wherein the computer system is in operative communication with the distribution center. The card distribution center, upon receiving the order, pulls the selected cards or prints the cards from blank card stock, prints the user's message and signature on the cards, places the applicable enclosures into the cards, prints the address on the envelope, and sends the card to the designated recipients or the customer.

(*Tackbary*, col. 2, lines 46-60 and col. 3, lines 16-24). Applicant respectfully submits that remotely communicating with a distribution center is different than "providing to the author a message kit comprising a first correspondence medium configured to receive the personal message" as recited in amended claim 11. In addition, Applicant respectfully submits that *Tackbary* fails to disclose or suggest either receiving or storing the first correspondence medium completed with the personal message.

Furthermore, *Tackbary* does not teach "providing to the author a message kit comprising ... a first directive configured to provide notification to a fiduciary," much less "notification to a fiduciary that a combination of the first correspondence medium completed with the personal message and an envelope configured to contain the first correspondence medium will be sent to the intended recipient in accordance with a preferred receipt date after the occurrence of a triggering event" as recited in amended claim 11 (emphasis added). Nor does *Tackbary*

disclose or suggest "receiving notification from the fiduciary of the occurrence of the triggering event" as recited in claim 11.

For at least the reasons described above, *Tackbary* fails to disclose, teach or suggest all of the features recited in amended claim 11. Therefore, Applicant respectfully submits that the rejection of claim 11 be withdrawn.

B. Dependent Claims 12-17

Since independent claim 11 is allowable, Applicant respectfully submits that claims 12-17 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.1988). Therefore, Applicant respectfully requests that the rejection of claims 12-17 be withdrawn.

C. Independent Claim 25

As provided in amended independent claim 25, Applicant claims:

A method for assisting an author in conveying a personal message, comprising:
providing a message kit;
receiving items provided in the message kit, the items completed with a personal message from the author and delivery instructions;
storing the completed items until notification of the occurrence of a triggering event; and
sending the completed item with the personal message in accordance with a preferred receipt date after the occurrence of the triggering event, as directed by the delivery instructions.

(Emphasis added). Applicant respectfully submits that amended independent claim 25 is allowable for at least the reason that *Tackbary* does not disclose, teach, or suggest at least "receiving items provided in the message kit completed with a personal message from the author and delivery instructions; storing the completed items until notification of the occurrence of a triggering event; and sending the completed item with the personal message in accordance with a preferred receipt date after the occurrence of the triggering event, as directed by the delivery instructions" as emphasized above.

More specifically, *Tackbary* teaches:

The present invention uses a computer system for permitting buyers to communicate with a card distribution center for selecting, ordering, and sending social expression cards and for maintaining records of intended recipients, occasion dates and orders made. The user selects a recipient from a recipient database wherein at least a name and an address of the recipient is stored in the database. The user selects a card from a card database based upon the selected recipient name and based upon a card-giving occasion stored in a master occasion database. The selected recipient name and card-giving occasion appear on a video display device as textual and graphical images.

Each independent customer or buyer communicates from a remote site to the distribution center. ...

The user then orders the selected card from the card distribution center wherein the computer system is in operative communication with the distribution center. The card distribution center, upon receiving the order, pulls the selected cards or prints the cards from blank card stock, prints the user's message and signature on the cards, places the applicable enclosures into the cards, prints the address on the envelope, and sends the card to the designated recipients or the customer.

(*Tackbary*, col. 2, lines 46-60 and col. 3, lines 16-24). Applicant respectfully submits that *Tackbary* fails to disclose or suggest either "receiving items provided in the message kit, the items completed with a personal message from the author and delivery instructions" or "storing the completed items until notification of the occurrence of a triggering event" as recited in amended claim 25 (emphasis added). Nor does *Tackbary* teach or suggest "sending the completed item with the personal message in accordance with a preferred receipt date after the occurrence of the triggering event", as directed by the delivery instructions" as recited in amended claim 25 (emphasis added).

For at least the reasons described above, *Tackbary* fails to disclose, teach or suggest all of the features recited in amended claim 25. Therefore, Applicant respectfully submits that the rejection of claim 25 be withdrawn.

D. Dependent Claims 26-32

Since independent claim 25 is allowable, Applicant respectfully submits that claims 26-32 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*,

837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.1988). Therefore, Applicant respectfully requests that the rejection of claims 26-32 be withdrawn.

E. Independent Claim 18

As provided in amended independent claim 18, Applicant claims:

A message kit, comprising:
means for recording a personal message;
means for forwarding the personal message and handling instructions to a holding party;
means for instructing a fiduciary that the holding party will send the personal message upon the occurrence of a specified date following the occurrence of a triggering event; and
means for receiving notification from the fiduciary of the occurrence of the triggering event.

(Emphasis added). Applicant respectfully submits that amended independent claim 18 is allowable for at least the reason that *Tackbary* does not disclose, teach, or suggest at least "means for instructing a fiduciary that the holding party will send the personal message upon the occurrence of a specified date following the occurrence of a triggering event; and means for receiving notification from the fiduciary of the occurrence of the triggering event" as emphasized above.

More specifically, *Tackbary* teaches:

The present invention uses a computer system for permitting buyers to communicate with a card distribution center for selecting, ordering, and sending social expression cards and for maintaining records of intended recipients, occasion dates and orders made. The user selects a recipient from a recipient database wherein at least a name and an address of the recipient is stored in the database. The user selects a card from a card database based upon the selected recipient name and based upon a card-giving occasion stored in a master occasion database. The selected recipient name and card-giving occasion appear on a video display device as textual and graphical images.

Each independent customer or buyer communicates from a remote site to the distribution center. ...

The user then orders the selected card from the card distribution center wherein the computer system is in operative communication with the distribution center. The card distribution center, upon receiving the order, pulls the selected cards or prints the cards from blank card stock, prints

the user's message and signature on the cards, places the applicable enclosures into the cards, prints the address on the envelope, and sends the card to the designated recipients or the customer.

(*Tackbary*, col. 2, lines 46-60 and col. 3, lines 16-24). Applicant respectfully submits that *Tackbary* does not teach "means for instructing a fiduciary that the holding party will send the personal message upon the occurrence of a specified date following the occurrence of a triggering event" as recited in amended claim 18 (emphasis added). Nor does *Tackbary* disclose or suggest "means for receiving notification from the fiduciary," much less "receiving notification from the fiduciary of the occurrence of the triggering event" as recited in claim 18.

For at least the reasons described above, *Tackbary* fails to disclose, teach or suggest all of the features recited in amended claim 18. Therefore, Applicant respectfully submits that the rejection of claim 18 be withdrawn.

F. Dependent Claims 19-20

Since independent claim 18 is allowable, Applicant respectfully submits that claims 19-20 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.1988). Therefore, Applicant respectfully requests that the rejection of claims 19-20 be withdrawn.

III. Claim Rejections under 35 U.S.C. §102(b)

Claims 21-24 have been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by *Thorp* ("Special needs--special plans: estate planning considerations for attorneys representing families with members with disabilities," *Journal of Disability Policy Studies*, Vol. 13, No. 1, p. 24, June 2002, hereafter "*Thorp*"). Applicant respectfully traverses this rejection as applied to pending claims 21-24.

As quoted in MPEP § 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051,

1053 (Fed. Cir. 1987). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b). In the present case, not every feature of the amended claims is represented in the *Thorp* reference.

A. Independent Claim 21

As provided in amended independent claim 21, Applicant claims:

A method for conveying a personal message, comprising:
recording a personal message;
forwarding the personal message and instruction to a holding party;
receiving confirmation that the holding party will forward the personal message on behalf of an author of the personal message in accordance with an author designated recipient receipt date following notification by a fiduciary of the occurrence of a triggering event; and
instructing the fiduciary to notify the holding party of the occurrence of the triggering event.

(Emphasis added). Applicant respectfully submits that amended independent claim 21 is allowable for at least the reason that *Thorp* does not disclose, teach, or suggest at least "forwarding the personal message and instruction to a holding party; receiving confirmation that the holding party will forward the personal message on behalf of an author of the personal message in accordance with an author designated recipient receipt date following notification by a fiduciary of the occurrence of a triggering event; and instructing the fiduciary to notify the holding party of the occurrence of the triggering event" as emphasized above.

The Office Action alleges that "Thorpe discloses a method for conveying a personal message where the personal message is recorded then forwarded to a lawyer (holding party) where the handwritten personal message is delivered on the occurrence of a triggering event such as death (Page 7, Letters of Intent)" (Office Action, page 5). More specifically, *Thorp* teaches:

The letter of intent, written by a parent, guardian, or other family member, describes the history and current status of the person with the disability and the family's hope for her or his future. ... Because it is not a legal document, the letter of intent can be handwritten, but the attorney can

have it prepared and typed alongside the rest of the legal documentation. ... Letters of intent are rarely used in litigation ...; however, few judges ignore such a document submitted as evidence of intent in a will or trust action.

(*Thorp*, page 7, lines 19-42). Thus, the Office Action appears to allege that a lawyer corresponds with a holding party and a letter of intent corresponds with a personal message. Applicant respectfully submits that having a lawyer prepare and type a letter of intent is different than "forwarding the personal message and instruction to a holding party" as recited in claim 21. In addition, Applicant respectfully submits that *Thorp* does not teach either "notification by a fiduciary of the occurrence of a triggering event" or "instructing the fiduciary to notify the holding party of the occurrence of the triggering event" as recited in amended claim 21. Nor does *Thorp* disclose or suggest "receiving confirmation that the holding party will forward the personal message on behalf of an author of the personal message in accordance with an author designated recipient receipt date following notification by a fiduciary of the occurrence of a triggering event" as recited in amended claim 21 (emphasis added).

For at least the reasons described above, *Thorp* fails to disclose, teach or suggest all of the features recited in amended claim 21. Therefore, Applicant respectfully submits that the rejection of claim 21 be withdrawn.

B. Dependent Claims 22-24

Since independent claim 21 is allowable, Applicant respectfully submits that claims 22-24 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.1988). Therefore, Applicant respectfully requests that the rejection of claims 22-24 be withdrawn.

IV. Claim Rejections under 35 U.S.C. §103(a)

Claims 1-5 and 9-10 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Cangiarella* (U.S. Patent Application Pub. No. 2004/0256281, hereafter

"*Cangiarella*"). Claims 6-8 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Cangiarella* in further view of *Kara* (U.S. Patent No. 6,208,980, hereafter "*Kara*"). Applicant respectfully traverses these rejections as applied to pending claims 1-10.

The U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquiries, also expressed in MPEP 2100-116, are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Applicant respectfully submits that a *prima facie* case of obviousness is not established using the art of record.

A. Independent Claim 1

As provided in amended independent claim 1, Applicant claims:

A message kit, comprising:

a first correspondence medium configured to receive a personal message from an author;

an envelope configured to enclose the first correspondence medium;

a second correspondence medium configured to receive information associated with an intended recipient of the personal message; and

a first directive medium configured to provide notification to a third party that a holding party in possession of the first correspondence medium completed with the personal message and the envelope will send the combination of the completed first correspondence medium and the envelope in accordance with a preferred receipt date communicated via the second correspondence medium, wherein the holding party retains the completed first correspondence medium and the envelope until after the occurrence of an author identified triggering event, wherein the third party is not the author.

(Emphasis added). Applicant respectfully submits that amended independent claim 1 is allowable for at least the reason that *Cangiarella* does not disclose, teach, or suggest at least "a first directive medium configured to provide notification to a third party that a holding party in possession of the first correspondence medium completed with the personal message and the envelope will send the combination of the completed first correspondence medium and the envelope in accordance with a preferred receipt date communicated via the second correspondence medium, wherein the holding party retains the completed first correspondence medium and the envelope until after the occurrence of an author identified triggering event" as emphasized above.

The Office Action appears to allege that a mailing label corresponds with a second correspondence medium and instructions 42 correspond with a first directive (Office Action, page 5). However, *Cangiarella* only teaches:

... the invention ... includes ...message paper 39, ... instruction sheet 42, mailing label(not shown) and protective sleeve 43. In preparation for sale the message paper39, instruction sheet 42, and protective sleeve 43 are wrapped around container 34, they are placed in shipping box 35, along with ... mailing label(not shown) ...

(*Cangiarella*, paragraphs 15-16). *Cangiarella* does not disclose or suggest any further details of the mailing label or the instruction sheet 42. As such, Applicant respectfully submits that *Cangiarella* does not teach "a first directive medium configured to provide notification to a third party" as recited in amended claim 1. Nor does *Cangiarella* disclose or suggest either "notification to a third party that a holding party in possession of the first correspondence medium completed with the personal message and the envelope will send the combination of the completed first correspondence medium and the envelope in accordance with a preferred receipt date communicated via the second correspondence medium" or "the holding party retains the completed first correspondence medium and the envelope until after the occurrence of an author identified triggering event" as recited in amended claim 1 (emphasis added).

For at least the reasons described above, *Cangiarella* fails to disclose, teach or suggest all of the features recited in amended claim 1. Therefore, Applicant respectfully submits that the rejection of claim 1 be withdrawn.

B. Dependent Claims 2-5 and 9-10

Because independent claim 1 is allowable over *Cangiarella*, Applicant respectfully submits that claims 2-5 and 9-10 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant respectfully requests that the rejection of claims 2-5 and 9-10 be withdrawn.

C. Dependent Claims 6-8

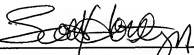
For the reasons discussed in section IV.A above, *Cangiarella* does not teach or suggest "a first directive medium configured to provide notification to a third party that a holding party in possession of the first correspondence medium completed with the personal message and the envelope will send the combination of the completed first correspondence medium and the envelope in accordance with a preferred receipt date communicated via the second

correspondence medium, wherein the holding party retains the completed first correspondence medium and the envelope until after the occurrence of an author identified triggering event" as recited in amended independent claim 1. The addition of *Kara* does not overcome these deficiencies. Because independent claim 1 is allowable over *Cangiarella* in view of *Kara*, Applicant respectfully submits that claims 6-8 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicant respectfully requests that the rejection of claim 6-8 be withdrawn.

CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 1-32 be allowed to issue. Any statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

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